

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

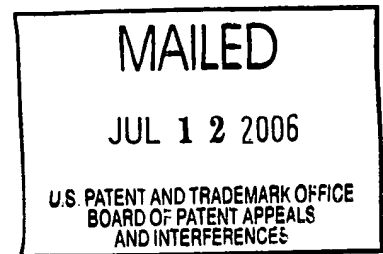
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAREN R. KLUTTZ, SANDEEP K. SINGHAL and THYRA RAUCH,
DAVID A. SCHELL

Appeal No. 2006-1248
Application No. 09/614,852

ON BRIEF



Before KRASS, JERRY SMITH, and SAADAT, **Administrative Patent Judges.**

JERRY SMITH, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-29.

The disclosed invention pertains to a method and apparatus for learning computer interface attributes.

Representative claim 1 is reproduced as follows:

1. A method of providing an interface with displayable computer files on a computer display, said method comprising the steps of:

(1) displaying a first displayable file on said computer display in a manner customized by an operator of said computer;

(2) storing data indicating a value of at least one attribute of the manner in which said first file was displayed associated with data indicating a type of said first file;

(3) when another file of the type of said first file is opened by an operator for display, accessing said stored data indicating said value of said at least one attribute; and

(4) displaying said another file of the type of said first file using said stored value of said at least one attribute.

The examiner relies on the following reference:

Lucus et al. (Lucus) 5,613,134 March 18, 1997

The following rejection is on appeal before us:

1. Claims 1-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lucas.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal

set forth in the examiner's answer. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived. See 37 C.F.R. §41.37(c)(1)(vii)(2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support the examiner's rejection of claims 1-29. Accordingly, we reverse.

We consider the anticipation of the following logical groups of claims, as separately argued by appellants [reply brief, page 2]:

- Group I: Claims 1-11 stand or fall together.
- Group II: Claims 12-20 stand or fall together.
- Group III: Claims 21-24 stand or fall together.
- Group IV: Claims 25-29 stand or fall together.

With respect to a rejection under 35 U.S.C. §102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1375-6, 77 USPQ2d 1321, 1325-6 (Fed. Cir. 2005), citing Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992).

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (internal citations omitted). "Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (internal citations omitted).

GROUP I, claims 1-11

We consider first the examiner's rejection of claims 1-11 that stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lucus. Appellants have argued independent claim 1 separately as the representative claim for this rejection [brief, page 7, reply brief, page 2].

With respect to representative claim 1, appellants argue: "Lucus does not teach either of steps (3) and (4), which recite 'when another file of the type of said first file is opened by an operator for display, accessing said stored data indicating said

value of said at least one attribute' and 'displaying said another file of the type of said first file using the same value of said at least one attribute as said first file,' respectively" [brief, page 7, ¶2]. We note that appellants have paraphrased step (4) which actually recites: "displaying said another file of the type of said first file using said stored value of said at least one attribute" [instant claim 1].

The examiner responds that Lucus teaches that the documents in the system consist of attributes, with each attribute having a name and a value, that are used to define the file type of each document in order to determine what operations are permissible, or what kinds of applications can be used for that type of grouping documents (see Lucus, col. 5 lines 10-17) [answer, page 7]. The examiner notes that Lucus teaches documents that are stored in repositories (i.e., a remote database or other servers throughout the network), where the repositories respond with one or more messages containing the unique identifier(s) (UID) associated with one or more documents that match the description in the user's search request to create a display of the document on a display device (See Lucus, Summary, col. 1 line 64 through col. 2 line 32) [answer, pages 7 and 8].

We note that support for the claimed file type is found within the instant specification as follows:

The file type can be indicated in many forms, including, but not limited to, the extension or extensions of the file name, such as .gif and .back.gif [specification, page 8, lines 1-3].

In the examples used herein, the file type is based on the file name extension or extensions. Thus, in these examples, anything after the first period in the file name is considered an extension and can be used to designate file type. It should be understood by those of skill in the art that other means for identifying files by type can be implemented in accordance with the invention. For example, rather than file name extension, the program might use attribute information contained within the file itself in a known location. Thus, when the file is being opened, these attributes can be read from the designated location and used to determine file type [specification, page 12, lines 17-26, cont'd page 13, lines 1-2].

"During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Claim language is given its plain, ordinary, or accustomed meaning to one of ordinary skill in the relevant art, unless the applicant has imparted a novel meaning to the language. Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002). The Court of Appeals for the Federal Circuit has determined that definitions of claim language need not be expressly defined but may be defined by implication in the specification, stating that "the specification is the 'single best guide to the meaning of a disputed term' and that the specification 'acts as a dictionary

when it expressly defines terms used in the claims or when it defines terms by implication.' " Phillips v. AWH Corp., 415 F.3d 1303, 1321, 75 USPQ2d 1321, 1332 (Fed. Cir. 2005) (en banc) (internal citations omitted).

We note that the support found in the instant specification for the claimed file type is not limited to the use of file extensions as a means of denoting a particular file type [specification, page 8, lines 1-3, page 12, lines 17-26, cont'd page 13, lines 1-2]. However, when claimed file type is properly construed in a manner consistent with the instant specification, we do not agree that the attributes or the unique identifier (UID) disclosed by Lucus fairly denote the file type of each document, as argued by the examiner. We note that the language recited by step (2) clearly requires an association of particular display attributes with a given file type [claim 1, emphasis added]. This is necessary so that when another file of the same type as the first file is opened, it will be displayed using the same attributes as the first file, as required by the language of representative claim 1 [emphasis added].

In contrast, Lucus teaches that each file is associated with its own display attributes [col. 4, lines 41-43, emphasis added]. Lucus defines an attribute as "a piece of data stored in a document" where each attribute has a name that uniquely identifies an attribute value within a document [col. 4, lines

20-23]. Lucus discloses that the set of attributes for any given document is arbitrary, and no particular attributes are required of all documents [col. 4, lines 10-13]. Lucus discloses several types of attributes, including executable scripts [col. 4, lines 44-50], and ephemeral attributes that define the display characteristics of an associated document, such as position and size [col. 6, lines 55-67, cont'd col. 7, lines 1-6]. Lucus also discloses intrinsic ephemeral attributes (that every document must have) that specify the display position of the document in a three-dimensional (x, y, z) workspace coordinate system [col. 7, lines 14-19, emphasis added]. Significantly, Lucus discloses that a document may have different ephemeral attributes when that document is associated with different workspaces [col. 7, lines 3-6].

Because Lucus discloses that the set of attributes for any document is arbitrary and also that a given document may have different ephemeral attributes when associated with different workspaces, we find that the attributes taught by Lucus do not fairly denote an identifiable group or class of files that share the same attribute values, thereby distinguishing the group of files as having a common type [emphasis added].

Likewise, we note that the Unique Identifier (UID) relied upon by the examiner cannot be used to denote an identifiable group or class of files (i.e., a file type) because Lucus

explicitly discloses that each UID uniquely identifies a document [col. 4, lines 16-18, emphasis added].

As pointed out by the examiner, Lucus does disclose a FIND tool that can be used to retrieve files that match a given file extension or common file type [col. 18, lines 45-50]. However, retrieving files with a FIND tool according to an extension or file type fails to teach recited steps (3) and (4), which specifically require: "when another file of the type of said first file is opened by an operator for display, accessing said stored data indicating said value of said at least one attribute" and "displaying said another file of the type of said first file using said stored value of said at least one attribute" [instant claim 1]. We note that the examiner has failed to point out where these specific limitations are taught in the Lucus reference. We note that the Lucus FIND tool teaches that files can be grouped together by type and displayed with a single command, as admitted by appellants [reply brief, pages 4 and 6]. However, we agree with appellants that this teaching has nothing to do with applying the display attributes of one file to another file having the same file type, as required by the language of representative claim 1 [reply brief, page 4].

We further note that the Lucus reference appears to be capable of displaying files in a juxtaposed and tiled manner that is similar to the display output of the instant invention [Lucus,

Fig. 4, see also instant invention, Fig. 2]. However, we find that the Lucus reference does so using an entirely different mechanism whereby each file or document is associated with its own display attributes instead of associating particular display attributes with a given file type, as required by the language of representative claim 1. Accordingly, we will not sustain the examiner's rejection of the claims in Group I (claims 1-11).

GROUP II, claims 12-20

We next consider the examiner's rejection of claims 12-20 that stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lucus. Appellants have argued dependent claim 12 separately as the representative claim for this rejection [brief, page 7, reply brief, page 2].

Because we agree with appellants that Group I claims 1-11 are not anticipated by Lucus, and because all the claims in Group II (claims 12-20) dependent directly or indirectly upon independent claim 1, we need not reach the questions presented with respect to these claims. Accordingly, we will not sustain the examiner's rejection of these claims for the same reasons discussed *supra* with respect to the claims in Group I.

GROUP III, claims 21-24

We next consider the examiner's rejection of claims 21-24 that stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lucus. Appellants have argued independent claim 21 separately as the representative claim for this rejection [brief, page 8, reply brief, page 2].

Appellants argue that independent claim 21 recites subject matter similar to claim 1 and, thus, distinguishes over Lucus for essentially the same reasons as claim 1. Appellants further argue that, in particular, claim 21 recites "using the same value to display said another file," that value being previously defined as "a value of at least one display attribute of a first displayable file on a computer" [brief, page 8].

We note that the examiner has rejected independent claim 21 for the same reasons relied upon in the rejection of independent claim 1 (Group I) [answer, page 5]. As pointed out by appellants, clause (5) of claim 21 recites: "using the same value to display said another file" where that value was previously defined in clause (1) as: "a value of at least one display attribute of a first displayable file on a computer" [brief, page 8]. We note that the examiner has failed to point out where these specific limitations are taught in the Lucus reference. We can find no teaching in the Lucus reference where the opening of another file (i.e., a second file) of the same type as a first

file is performed using the display attribute value associated with the type of the first file to display the second file where the second file is the same type as the first file, as required by the language of representative claim 21. While *Lucus* does disclose a particular embodiment where a first user and a second user access separate copies of the same document, this teaching fails to meet the explicit requirement of "another file," as claimed [*Lucus*, col. 6, lines 31-35; instant claims 1 and 21]. Accordingly, we will not sustain the examiner's rejection of the claims in Group III for essentially the same reasons discussed *supra* with respect to the claims in Group I.

GROUP IV, claims 25-29

We next consider the examiner's rejection of claims 25-29 that stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Lucus*. Appellants have argued dependent claim 25 separately as the representative claim for this rejection [brief, page 8, reply brief, page 2].

Because we agree with appellants that Group III claims 21-25 are not anticipated by *Lucus*, and because all the claims in Group IV (claims 25-29) dependent directly or indirectly upon independent claim 21, we need not reach the questions presented with respect to these claims. Accordingly, we will not sustain

the examiner's rejection of these claims for the same reasons discussed *supra* with respect to the claims in Group III.

For at least the aforementioned reasons, we agree with appellants that the examiner has failed to meet his/her burden of presenting a *prima facie* case of anticipation. In summary, we will not sustain the examiner's rejection of any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-29 is reversed.

REVERSED

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